

REMARKS

Claims 27, 28, and 31-40 remain in the case. Favorable reconsideration is respectfully requested.

The following remarks address the issues presented in the Office Action in the order in which they appear.

Rejection of Claims 27 and 31-35 Under 35 U.S.C. §102(e) Over Lebel et al.

This rejection is respectfully traversed as being rendered moot in view of the Rule 131 Declaration of inventors Sandra Austin-Phillips, Richard R. Burgess, Thomas L. German, and Thomas Ziegelhoffer, filed herewith. Applicants respectfully submit that the showing contained in the Rule 131 Declaration successfully antedates the Lebel et al. reference, thereby removing the Lebel et al. patent as prior art to the claims of the subject application.

As noted in paragraph 2 of the Declaration, the subject application is a CIP of a parent application, Serial No. 08/833,495, filed June 26, 1997, and now issued as U.S. Patent No. 5,981,835. A copy of the parent application as filed is included as Exhibit A of the Declaration. As described in paragraph 3 of the Declaration (and with specific reference to the parent application), the claims of the present application are clearly enabled by the description contained in the parent application as filed. Thus, the now-pending claims are entitled to the June 26, 1997 filing date of the parent application.

Paragraphs 4-7 of the Declaration, and the accompanying Exhibits B and C contain objective evidence showing that the present inventors had conceived of and reduced the now-claimed invention to practice prior to September 12, 1996, the earliest claimed priority date of the Lebel et al. patent. Note that September 12, 1996 is less than one year prior to June 26, 1997, the effective filing date of the present application. Thus, the Lebel et al. reference can be removed as available prior art by a proper showing under 37 CFR §1.131. Applicants respectfully submit that paragraphs 4-7 of the attached Declaration

provide such a showing.

Specifically, paragraph 5 and Exhibit B of the Declaration show that co-inventor Tomas Ziegelhoffer cloned and expressed the E2 and E3 cellulases of *T. fusca* in tobacco at a date prior to September 12, 1996. Similarly, paragraph 6 and Exhibit C of the Declaration evidence the expression of these same cellulases in alfalfa. The explicit purpose of expressing the cellulases in alfalfa was to use the enzymes so produced in biomass conversion (*i.e.*, for, among other things, ensilement).

In light of the Rule 131 Declaration submitted herewith, Applicants respectfully submit that the rejection of Claims 27 and 31-35 under 102(e) in view of Lebel et al. is no longer tenable. Withdrawal of this rejection is now requested.

Rejection of Claims 27-28 and 31-40 Under § 103(a) Over Lebel et al. In View of Zhang et al.

This rejection is respectfully traversed because Applicants submit that the Lebel et al. reference has been removed as available prior art as a consequence of the Rule 131 Declaration submitted herewith.

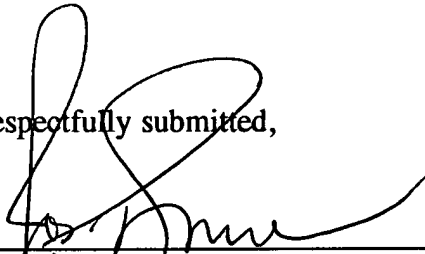
With the Lebel et al. patent being unavailable as prior art to the present claims, Applicants traverse this rejection because the remaining reference to Zhang does not disclose or suggest the present invention. The Zhang et al. paper is limited entirely to a description of cloning the E3 cellulase of *T. fusca* and expressing this cellulase in *Streptomyces lividans*. But *S. lividans* is a bacteria. The Zhang et al. paper is entirely silent regarding expressing the E3 cellulase in any type of plant host.

Applicants therefore submit that the rejection of Claims 27-28 and 31-40 under 35 USC § 103(a) in view of Lebel et al. and Zhang et al. is no longer tenable. Withdrawal of the same is requested.

CONCLUSION

Applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,



Joseph T. Leone, Reg. No. 37,170
Colin L. Fairman, Reg. No. 51,663
DEWITT ROSS & STEVENS S.C.
8000 Excelsior Drive, Suite 401
Madison, Wisconsin 53717-1914
Telephone: (608) 831-2100
Facsimile: (608) 831-2106

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

Mail Stop Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date of Deposit: 10-16-03

Signature: Marcelo Layton